REMARKS

This is a full and timely response to the non-final Office Action of July 1, 2004.

Reexamination, reconsideration, and allowance of the application and all presently pending

claims are respectfully requested.

Upon entry of this First Response, claims 1-5, 8-14, and 17-24 are pending in this

application. The specification and claims 1, 10, 17, 18, and 20 are directly amended herein.

Furthermore, claims 21-24 are newly added, and claims 6, 7, 15, and 16 are canceled without

prejudice or disclaimer. It is believed that the foregoing amendments add no new matter to the

present application.

Response to 35 U.S.C. §112 Rejections

Claims 6, 7, 15, and 16 presently stand rejected under 35 U.S.C. §112, second

paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter

which Applicants regard as the invention. Claims 6, 7, 15, and 16 have been canceled via the

amendments set forth herein making the 35 U.S.C. §112 rejections of these claims moot.

Accordingly, Applicants respectfully request that the 35 U.S.C. §112, second paragraph,

rejections be withdrawn.

<u>Response to 35 U.S.C. §102 Rejections</u>

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art

reference disclose each element of the claim. See, *e.g.*, *W.L. Gore & Assoc., Inc. v. Garlock,*

Inc., 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

Claim 1

Claim 1 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by

Motoyama (U.S. Patent No. 6,009,436) and as allegedly being anticipated by *Adobe*

(www.adobe.com/products/framemaker/sgmlwhatsnew.html). Claim 1 presently reads as

follows:

> 1. An apparatus for generating files, the apparatus comprising:
> a first logic configured to perform a technical writing tool algorithm, the technical writing tool algorithm for receiving input describing a particular selected format and content for a document, the technical writing tool algorithm for processing said input to generate a first markup language file based on an elements file, said elements file defining elements included in said first markup language file and a structure for each of said elements, wherein said first markup language file is printable as a hardcopy document, said first markup language file including first markup language formatting information; and
> a second logic configured to receive the first markup language file and to perform a conversion algorithm that converts the first markup language file into a second markup language file *based on at least one of a plurality of style templates that are external to said elements file, said at least one style template mapped to at least one of said elements and defining a style for said at least one element*, wherein said second markup language file includes a second markup language formatting information describing a particular on-line format and content of said document. (Emphasis added).

Applicants respectfully assert that the cited art fails to disclose at least the features of claim 1

highlighted above. Accordingly, the 35 U.S.C. §102 rejection of claim 1, as amended, is

improper.

In this regard, *Motoyama* appears to disclose an apparatus that converts SGML

documents into HTML documents. However, there is nothing in *Motoyama* to indicate that the

- 10 -

apparatus uses a "plurality of style templates," as described by amended claim 1. Further, it is alleged in the Office Action that *Adobe* "discloses WebWorks Publisher for use with FrameMaker+SGML." However, there is nothing in *Adobe* to indicate that WebWorks Publisher or FrameMaker+SGML uses a "plurality of style templates," as described by amended claim 1.

For at least the reasons set forth above, Applicants assert that the cited art fails to disclose each feature of claim 1, as amended. Accordingly, 35 U.S.C. §102 rejection of claim 1 should be withdrawn.

Claims 2-5, 8, and 9

Claims 2-5, 8, and 9 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Motoyama* and as allegedly being anticipated by *Adobe*. Applicants submit that the pending dependent claims 2-5, 8, and 9 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-5, 8, and 9 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 10

Claim 10 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated

by *Motoyama* and as allegedly being anticipated by *Adobe*. Claim 10 presently reads as follows:

> 10. A method for generating files, the method comprising:
> processing input describing a particular desired format and content for a document;
> generating a first markup language file based on said input and on an elements file, said elements file defining elements included in said first markup language file and a structure for each of said elements, wherein said first markup language file is printable as a hardcopy document, said first markup language file including first markup language formatting information; and
> converting the first markup language file into a second markup language file *based on at least one of a plurality of style templates that are separate from said elements, said at least one style template mapped to at least one of said elements and defining a style for said at least one element*, wherein said second markup language file includes second markup language formatting information that describes a particular on-line format and content of said document when it is placed on-line. (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of pending claim 1,

Applicants respectfully assert that the cited art fails to disclose at least the features of claim 10

highlighted above. Accordingly, 35 U.S.C. §102 rejection of claim 10 should be withdrawn.

Claims 11-14 and 17-19

Claims 11-14 and 17-19 presently stand rejected in the Office Action under 35 U.S.C.

§102 as allegedly being anticipated by *Motoyama* and as allegedly being anticipated by *Adobe*.

Applicants submit that the pending dependent claims 11-14 and 17-19 contain all features of

their respective independent claim 10. Since claim 10 should be allowed, as argued

hereinabove, pending dependent claims 11-14 and 17-19 should be allowed as a matter of law

for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 20

Claim 20 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated

by *Motoyama* and as allegedly being anticipated by *Adobe*. Claim 20 presently reads as follows:

> 20. A computer program for generating files, the computer program
> embodied on a computer-readable medium, the computer program comprising:
> a first algorithm, the first algorithm processing input describing a particular
> desired format and a content for a document to generate a first markup language
> file based on an elements file, said elements file defining elements included in
> said first markup language file and a structure for each of said elements, wherein
> said first markup language file is printable as a hardcopy document, said first
> markup language file including first markup language formatting information;
> and
> a second algorithm, the second algorithm converting the first markup
> language file into a second markup language file *based on at least one of a*
> *plurality of style templates that are external to said elements file, said at least*
> *one style template mapped to at least one of said elements and defining a style*
> *for said at least one element,* wherein said second markup language file includes
> second markup language formatting information that describes a particular on-
> line format and content of said document when it is placed on-line. (Emphasis
> added).

For at least the reasons set forth hereinabove in the arguments for allowance of pending claim 1,

Applicants respectfully assert that the cited art fails to disclose at least the features of claim 20

highlighted above. Accordingly, 35 U.S.C. §102 rejection of claim 20 should be withdrawn.

Claim 21

Claim 21 has been newly added via the amendments set forth herein. Claim 21

presently reads as follows:

> 21. An apparatus for generating files, comprising:
> logic configured to generate a markup language file based on an elements file, said elements file defining elements included in said markup language file and a structure for each of said elements, said logic configured to define a set of style templates separate from said elements file, each of said style templates mapped to a corresponding one of said elements and defining a style for said corresponding element, wherein said markup language file has formatting information based on at least one of said style templates mapped to at least one of said elements included in said markup language file.

Applicants respectfully assert that the cited art fails to disclose or teach each of the above

features of pending claim 21. Accordingly, Applicants submit that claim 21 is allowable.

Claim 22

Claim 22 has been newly added via the amendments set forth herein. Applicants submit

that the pending dependent claim 22 contains all features of its respective independent claim 21.

Since claim 21 should be allowed, as argued hereinabove, pending dependent claim 22 should

be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed.

Cir. 1988).

Claim 23

Claim 23 has been newly added via the amendments set forth herein. Claim 23

presently reads as follows:

> 23. A method for generating files, comprising:
> storing an elements file defining markup language file elements and a structure for each of said elements;
> maintaining a plurality of style templates separate from said elements, each of said style templates mapped to at least a respective one of said elements and defining a style for said one element;
> generating a markup language file based on said elements file and at least one of said style templates that is mapped to at least one of said elements included in said markup language file, said markup language file having formatting information based on said at least one style template; and
> displaying an image of a document defined by said markup language file.

Applicants respectfully assert that the cited art fails to disclose or teach each of the above

features of pending claim 23. Accordingly, Applicants submit that claim 23 is allowable.

Claim 24

Claim 24 has been newly added via the amendments set forth herein. Applicants submit

that the pending dependent claim 24 contains all features of its respective independent claim 23.

Since claim 23 should be allowed, as argued hereinabove, pending dependent claim 24 should

be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed.
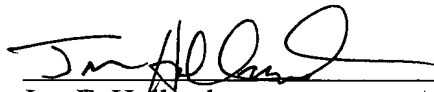
Cir. 1988).

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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